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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,170	10/21/2003	Igor Y. Khandros	P197-US	3947

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KEN BURRASTON
KIRTON & MCCONKIE
PO BOX 45120
SALT LAKE CITY, UT 84145-0120

EXAMINER	
NGUYEN, TUNG X	

ART UNIT	PAPER NUMBER
2829	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,170	KHANDROS ET AL.	
	Examiner	Art Unit	
	Tung X. Nguyen	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-62* is/are pending in the application.

4a) Of the above claim(s) *20-55* is/are withdrawn from consideration.

5)☒ Claim(s) *13-15 and 62* is/are allowed.

6)☒ Claim(s) *1,3-11,16-19 and 56-61* is/are rejected.

7)☒ Claim(s) *12* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/25/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Petition for Withdraw of Final Restriction Requirement

1. The petition for withdrawal of the final restriction requirement filed on May 24, 2006 is considered as a request for reconsideration. Following is the examiner' s response to the request.

MPEP 803 states "Under the statute an application **may** properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP 806.04-806.04(i)) or distinct (MPEP 806.05-806.05(I)). If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions", and "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent (see MPEP 802.01, 8-6.05-806.05(i)); and (B) There must be a serious burden on the examiner if restriction is required (see MPEP 803.02, 806.04(a)-806.04(i), 808.01(a), and 808.02)".

When working on the first non-final Office Action dated 05/02/05, the examiner had made extra efforts to examine 44 claims, which recited diverse inventions.

In response to the non-final Office Action, applicants added new claims 51-61. The newly added claims 51-61 may have some features similar to those of the claims 1-19 but the two sets of claims are distinct from each other, for example: Claim 1 recites "A method of testing a test system comprising a tester and a test station, said method comprising: transmitting test data wirelessly from said tester to said test station, said

test data representing a plurality of tests for testing an electronic device; and testing said electronic device by running said plurality of test on said electric device at said test station" and claim 56 recites "A method of testing in a system comprising a tester and a test station, said method comprising: transmitting a test directive wirelessly from said tester to said test station; and running at said test station a test on said electric device in accordance with said test directive".

The two species are distinct because Species I (claims 1-19) does not require the claimed feature "a test directive" of Species II (claims 56-61) for patentability and Species II does not require the claimed feature "said test data representing a plurality of tests for testing an electronic device" of Species I for patentability.

Without a restriction, addressing a large number (61) of claims reciting many inventions is a serious burden of search and examination to the examiner. There may be some overlapping in areas of search; the search and examination still need to focus on the specific features of the distinct inventions and/or species. The restriction requirement is still deemed proper.

Therefore, the request for the withdrawal of the final restriction requirement is denied. Because claim 56 is generic to Species I and Species II, when claim 56 is allowed, all the claims dependent on claim 56 will be allowed, including the claims of the non-elected Species.

2. The claims 20-55 were withdrawn from further consideration.

Response to Arguments

3. Applicant's amendment changes the scope of the claims even though the features added to claim 56 was previously claimed in claim 2.

4. Applicant's arguments with respect to claims 1, 2-12, 16-19 and 56-61 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-4, 16-19, 56-58, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Brady et al. (u.s.p 6,236,223).

As to claims 1, 56, 61, Brady et al. disclose in Figs. 1-2a-d, a method of testing in a system comprising a tester (228) and test station (216), said method comprising step of: the tester (228) for transmitting a plurality of test directive wirelessly from said tester to said test station (col. 4, lines 57-60); the test station for running a plurality of test on an electronic device (212) in accordance with the test directive (col. 4, lines 32-40); the test station for transmitting results of said test wirelessly form said test station to said tester (col. 3, lines 45-50).

As to claim 3, Brady et al. disclose in Figs. 1-2a-d, testing further comprises testing a plurality of electronic devices (212) at the test station using the transmitted test data.

As to claims 4, 57-58, Brady et al. disclose in Figs. 1-2a-d, the test directive comprises a command, and the running step comprises said test station decoding the command (col. 4, lines 32-40).

As to claims 16-18, Brady et al. discloses in Fig. 2c, the test station (238) comprising a prober (214) and semiconductor wafer (212) with die within the wafer.

As to claim 19, Brady et al. discloses the electronic device (wafer) comprising a multi-chip module (die). The examiner consider the wafer to be equivalent to a multi-chip module.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady et al. (u.s.p 6,236,223); in view of Roy et al. (u.s.p 6,480,978)

As to claim 59, Brady et al. disclose in Figs. 1-2a-d, all of the claimed features except for the test directive comprise a test vector. However, Roy et al. disclose a test vector comprising data and locations to which the data to be written (col. 2, lines 15-20) for testing particular device under test (DUT). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify

system of Brady et al., and provide the test vector, as taught by Roy et al., for testing a particular device under test of a the group of devices under test.

As to claim 60, Brady et al. disclose in Figs. 1-2a-d, the locations comprise identifications of probes (218 of figure 2d) through which the test data is to be written to the electronic device (212).

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady et al. (u.s.p 6,236,223), in view of Nakata et al. (u.s.p 5,825,193)

As to claim 5, Brady et al. disclose in Figs. 1-2a-d, all of the limitations except for the electronic device comprising a self-test circuitry. However, Nakata et al. disclose the electronic device comprising a self-test circuitry (col. 2, lines 58-62) for testing each semiconductor device. Therefore, It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify system of Brady et al., and provide the self-test circuitry, as taught by Nakata et al., for testing each semiconductor device.

10. Claims 6-11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady et al. (u.s.p 6,236,223), in view of Deckert et al. (u.s.p 6,137,303).

As to claims 6-7, 9-11, Brady et al. disclose in Figs. 1-2, the test system except for a plurality of test stations. However, Deckert et al. disclose in Figs. 1, the plurality of test stations (32 of figure 1) for saving time in testing plurality of electronic devices. Therefore, It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the system of Brady et al., and provide the plurality of test stations, as taught by Deckert et al. for saving time in testing plurality of

electronic devices. Furthermore, the combined teaching of Brady and Decker do not teach the step of transmitting test data to at least two of the test stations with the same or different time. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to transmitting the test data to at least two of the test stations at the same or different time for testing plurality of devices at the plurality of the stations.

As to claim 8, Deckert et al. disclose in Figs. 1, the test data transmitted to at least one of the test station is different than test data transmitted to another of the test stations (via controller 25 of figure 1).

Allowable Subject Matter

11. Claims 13-15, 62 are allowed and indicated in the last Office Action.

12. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As to claim 12, the prior art does not teach the step of adding another test station comprises said other test station transmitting wirelessly to said tester a request to be added to said test system.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung X. Nguyen whose telephone number is (571) 272-1967. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha T. Nguyen can be reached on (571) 272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN
8/2/06

HA TRAN NGUYEN
SUPERVISORY PATENT EXAMINER